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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P1976US00	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(e)] on <u>Oct. 4, 2005</u> Signature <u>Lori Boulware</u> Typed or printed name <u>Lori Boulware</u>		Application Number <u>10/646,162</u>	Filed <u>8/22/2003</u>
		First Named Inventor <u>THOMAS KETH C.</u>	
		Art Unit <u>2632</u>	Examiner <u>HUNNINGS, TRAVIS</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>35,987</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Jeffrey A. Proehl</u> Typed or printed name <u>(605) 232-1967</u> Telephone number <u>OCTOBER 4, 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

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MEMO IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1 through 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bush et al. (Bush; US Patent 5,214,762). Claims 8 through 13 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bush et al.

In the "Response to Arguments" section in the final Action, it is stated that:

The lack of indication as set forth by Bush is still a form of indication to the user that a continuous operating condition associated with the electronic device is occurring, specifically that currently no I/O writes are being performed by the computer (electronic device) on the hard drive (component of the electronic device). There is no mention in the claim language of claim 1 of a limitation to provide indication of a power on or power off condition.

While the language of claim 1 does not literally require "power on" or "power off", claim 1 does require a "first continuous *operating* condition", and not just a "first continuous condition". Therefore, the language of claim 1 requires that the first condition be an *operating* condition as well as a continuous condition, and not simply a condition, such as "power on" or "power off". Thus, it is submitted that the interpretation proposed in the Office Action simply ignores the presence of the "operating" requirement, and the line of argument in the Office Action renders this term meaningless in the claim as it is based upon an "inoperable" or non-operable (or "power off") satisfying the "first continuous *operating* condition" requirement of claim 1.

Furthermore, the assertion that the "lack of indication as set forth by Bush is still a form of indication", apart from the inherent incongruity in this statement, has been addressed previously by establishing that the "lack of indication" by the indicator in the Bush system does not provide the user with any reasonably reliable information as to the condition of the system, as the "lack of indication" *could* mean that:

- 1) the disk drive of the Bush system is not active at the present time, but the system is in a power on state; OR
- 2) the entire Bush system is not in a power on state (e.g., "power off").

Thus, to make any determination of the condition of the Bush system, the user is forced to speculate which of these possibilities is actually occurring. Further, neither of these possibilities represents a "continuous operating condition" of an electronic device, as compared to a component of the electronic device, as set forth in claim 1. Thus, not only does the "lack of indication" *not* provide the user with any definite indication of a single condition, it also does not address a continuous operating condition of the electronic device, but only a component of the device.

Moreover, the statement in the Office Action that “[t]here is no mention in the claim language of claim 1 of a limitation to provide indication of a power on or power off condition.” is clearly not accurate with respect to claim 9, which requires “an activity indicator on the electronic device, the activity indicator being configured to *provide a continuous indication of the presence of a power-on operating condition of the electronic device*” and “wherein the activity indicator is *interrupted from continuously indicating the presence of the power-on operating condition of the electronic device* by the activity signal to thereby produce an indication of the intermittent operating condition of the storage device”. (Although the rejection of claim 9 states that claim 9 “is interpreted and rejected as claim 1 stated above”, it is submitted that the differences in language between claims 1 and 9 make it improper to interpret these claims in an identical manner as was done in the Office Action.)

Secondly, in the “Response to Arguments” section, it is stated that (*italics emphasis added*):

The indications of the disclosed invention and claimed invention both correspond to the same events; the activation and non-activation of an electronic device such as a hard disk drive. The choice of indications themselves, whether they are continuously on and interrupted on activation or continuously off and turned on during activation *perform the same functionality and indication to the user*. Therefore it would have been obvious to one of ordinary skill in the art to have chosen either of the above mentioned indication choices.

Again, this line of argument appears to overlook the requirements of claim 1 which regards “An alternate indicator for *a component of an electronic device*” and requires “the activity indicator configured to provide a continuous indication of the presence of *a first continuous operating condition associated with the electronic device*” and “the activity detection circuit configured to generate an activity signal when detecting *a second periodic operating condition associated with the component*” (*all emphasis added*). The line of argument in the Office Action appears to ignore the distinction set forth in the language of the claim between the electronic device and the component of the electronic device, and the corresponding first *continuous operating* condition of the *electronic device* and the second *periodic operating* condition of the *component*.

Furthermore, because of the indefiniteness of what the indicator of the Bush system is “indicating” to the user when the indicator is extinguished, as noted above, between the disk drive being inactive and the system being off, it is submitted that the claimed invention and the indicator described in the Bush system do not have the “same functionality” as asserted in the Office Action. Moreover, the Bush system additionally requires the use of a conventional system power on/power off indicator in order to be able to convey the same information conveyed by the indicator of the

claimed invention, which further shows that the indicator of the Bush system does not have the "same functionality" of the claimed invention.

Turning to the rejections of the Office Action, the Bush patent discusses a disk drive activity indicator in which an LED is turned on *only* when disk drive activity is detected. More particularly, claim 1 recites "a continuous indication of the presence of a *first continuous operating condition associated with the electronic device*". In the Office Action, it is stated that (emphasis added):

The claimed activity indicator configured to provide a continuous indication of the presence of a first continuous operating condition associated with the electronic device is met by the LED being triggered in response to I/O operations involving the hard drive (abstract) and therefore by definition the LED is not triggered (turned off) during the period when the computer is on but there is no activity involving the hard drive. Therefore the LED is continually indicating that there is no activity in the hard drive while it is off;

It appears that the rejection is based upon the position that a *lack* of activity by the disk drive is a "continuous operating condition", and thus the absence of any indication from the disk drive activity indicator of Bush is actually a "continuous indication" of that continuous *lack* of activity by the disk drive. However, it is submitted that the *non-operation* of the disk drive, which is what leads to the disk drive indicator of Bush remaining turned off, is not considered by one of ordinary skill in the art to be a "continuous operating condition" as required by claim 1.

Contrary to the allegation in the Office Action that "the LED is not triggered (turned off) during the period when the computer is on but there is no activity involving the hard drive", a user of the Bush system, viewing the LED of the disk drive activity indicator, does not know if the LED is "turned off" because there is presently no disk drive activity, or is "turned off" because the entire computer system is simply "turned off". Absent the presence of some disk drive activity, the Bush indicator is not only "turned off" when there is no disk drive activity, but is also "turned off" when the computer is "turned off". Thus, unless there is currently some disk drive activity actually occurring, one has no idea from the Bush indicator whether the computer is "on" or "off".

Claim 1 also requires "the activity detection circuit configured to generate an activity signal when detecting a second periodic operating condition *associated with the component*". In contrast to this requirement, the positions set forth in the Office Action do not appear to recognize any difference between "a first continuous operating condition *associated with the electronic device*" and "a second periodic operating condition *associated with the component*". The positions taken in the Office Action appear to all relate to the operating states of the disk drive of Bush, such as in the portion of the Office Action where it is stated that (emphasis added):

The claimed activity indicator being interrupted from continuously indicating the presence of the first continuous operating condition by the activity signal, thereby producing an indication of the second periodic operating signal is met by the LED being triggered (turning on) when the triggering logic detects an I/O function relating to the hard drive (abstract).

It is submitted that the Bush patent would not lead one of ordinary skill in the art to consideration of operating conditions of both "an electronic device" and "a component of the electronic device", as required by claim 1, and the rejection of the office Action appears to reflect this, as only the operating states of the disk drive (and not the operating condition of the entire Bush computer system) are discussed. But, as noted above, the user of the Bush system is not provided with any information as to whether the computers system is turned on or turned off, unless, and only when, disk drive activity is actually occurring.

The rejection of claim 1 in the Office Action further alleges that (emphasis added):

The indications of the disclosed invention and claimed invention both correspond to the same events; the activation and non-activation of an electronic device such as a hard disk-drive. The choice of indications themselves, whether they are continuously on and interrupted on activation or continuously off and turned on during activation, does not merit novel inventive material. Therefore it would have been obvious to one of ordinary skill in the art to have chosen either of the above mentioned indication choices.

The reference to "inventive material" appears to reflect a belief that the claimed invention is "obvious" in view of the Bush patent. It is noted that the rejection in the Office Action presents no evidence to support a contention that one of ordinary skill in the art would be motivated to modify the Bush system to meet the claimed invention, and it is submitted that there is no motivation presented by Bush that would motivate such a change of the Bush system.

It appears that this portion of the rejection is taking the position that the difference between the requirements of claim 1, and the disclosure of the Bush patent, is merely a "matter of design choice", or some similar reasoning. However, the claimed invention is not merely another equivalent "choice" that one of ordinary skill in the art could make for indicating disk drive activity, as the function of the claimed system provides additional capabilities compared to the Bush system.

In particular, it is submitted that the disk drive activity indicator system taught by Bush, and its manner of indicating disk drive activity, is completely incapable of providing an effective indication of the operating condition of the Bush system, as the disk drive activity indicator only illuminates during the time that disk drive accesses or interrupts are actually occurring. More significantly, Bush discloses that the disk drive activity indicator is "off" during times that specific

disk activity is not occurring, but would also be "off" when the Bush system is powered down (and thus there is no disk activity because the power to the system is cut off). As a result, a user of the Bush system would not be able to look at its disk drive activity indicator and be able to tell if the system is powered up, unless disk activity happened to coincide with the precise time that the user looked at the disk drive activity indicator.

In contrast, with the system of claim 1, one simply has to look to the claimed indicator to see if power is being supplied to the system, and if the indicator is periodically being interrupted (such as by flashing off), one also knows that disk activity is occurring. As noted above, and in the specification of the present patent application, there is a clear benefit to having a single indicator that provides an indication of the operating conditions of two elements.

Further, it was not alleged in the Office Action that the Bush patent, or the prior art, provides one of ordinary skill in the art with any motivation to modify the Bush system to meet the requirements of claim 1, or claim 5. It is submitted that one of ordinary skill in the art, considering the Bush patent and the knowledge that heretofore power indicators and disk activity indicators are separate elements, would presume that the Bush system employs a separate power on indicator, and thus any attempt to further modify the Bush disk drive activity indicator to also indicate the power status of the system would be superfluous.

It is therefore submitted that the Bush patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1 and 5, especially with the requirements set forth above, and therefore it is submitted that claim 1 is allowable over the prior art. Further, claims 2 through 4 and claims 6 through 7 are also submitted to be in condition for allowance.

With respect to claim 8, which requires "wherein the continuous indication by the activity indicator is characterized by illumination of the activity indicator, and interruption of the continuous indication of the activity indicator is characterized by extinguishing the activity indicator", and the claimed activity indicator, especially as required by claim 8, provides the user with more information about the continuous operating condition of the electronic device than the Bush system is capable of. The Bush system has to employ a separate power indicator in order to communicate operational condition information provided by the claimed activity indicator. It is therefore submitted that the Bush indicator does not provide the "same functionality" as the claimed invention.

Withdrawal of the §103(a) rejection of claims 1 through 13 is therefore respectfully requested.